UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,482	02/14/2000	Yoshinori Takahashi	35.G1872D	6662

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EXAMINER
GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary

	Application No.	Applicant(s)
Office Action Summary	09/503,482	Takahashi
	Examiner	Art Unit
	M. Marcia	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 11/17/03 .

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 45, 46, 48, 49 and 51-65 is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☒ Claim(s) 45, 46, 48, 49 and 51-65 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some* c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing
out and distinctly claiming the subject matter which the applicant regards as
his invention.

2.   Claim 45 recites the limitation "the inquiry" in line 11.

There is insufficient antecedent basis for this limitation in the

claim. It is not clear whether the inquiry in line 13 refers to

the inquiry of the inquirer or the determiner. Claim 51 have

similar problems. Clarification or corrections are required.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms

the basis for all obviousness rejections set forth in this Office

action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

4.   Claims 45,46,48,49 and 51-65 are rejected under 35

U.S.C. 103(a) as being unpatentable over <u>Sasaki</u> (U.S. 5,228,118) in view of <u>Gase et al</u> (U.S. 5,580,177).

As to claim 45, <u>Sasaki</u> discloses an information processing apparatus (reads on the data processing device) comprising: an inquirer adapted (see figures 1-2: inquiring means) for making an inquiry about a printer language (e.g. language interpreter) supported by the printer (see figures 1 and 2) connected to the network by sending an inquiry about information to the network (reads on col. 9, lines 53-65); and a receiver (see column 2, line 60 to column 3, line 13, and/or fig. 4) adapted for receiving information about the printer language supported by the printer, wherein the information about the printer language is sent in response to the inquiry (see column 2, line 60 through column 3, line 13). <u>Sasaki</u> discloses changing of the printer from one type to another (see column 2, lines 3-4 and 49-50), and sending a broadcast inquiry to the printer(s) connected to the network (reads on col. 9, lines 53-65).

However, <u>Sasaki</u> does not teach a determiner adapted for determining a presence or an absence of a printer selected by a user connected to a network by inquiring information of the network.

<u>Gase et al</u> (in the same field of endeavor "network printing" teaches a printing network having a plurality of clients (10, 12 and 14) connected to a server (16), and the server (16) is

further connected to a plurality of printers (18, 20 and 22)(see

figure 1). Gase et al teaches a determiner adapted to send an

inquiry about information to a network in order to determine a

presence or an absence of a printer selected by a user connected

to the network (see col. 1, lines 43-48, col. 4, lines 35-37, and

col. 5. Line 64 thru col. 6, line 17, the selected printer by the

user reads on col. 6, lines 45-52); and making an inquiry about a

printer language supported by the new added printer connected to

the network if the determiner determines the presence of the new

added printer connected to the network (i.e., if a new printer is

added or connected to the network, a new printer driver must be

installed on the client host computer, so that the client will be

able to use or print on the newly added printer) (see col. 1,

lines 43-48 and col. 6, lines 3-17).

Therefore, it would have been obvious to one person having

ordinary skill in the art at the time the invention was made to

have modified Sasaki wherein: the information processing

apparatus includes a determiner adapted for determining a

presence or an absence of a printer selected by the user

connected to a network by sending an inquiry, and wherein the

inquiry circuit is adapted for making an inquiry about a printer

language supported by the printer connected to the network if the

determination circuit determines the presence of the printer is

connected to the network.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified network printing system of Sasaki by the teaching of Gase et al because of the following reason(s): (1) to allow the user to known if the selected printer is currently connected to the network and available to receive a job; (2) for the reasons taught by Gase et al (see column 1, lines 43-48 and col. 4, lines 35-37); (3) to determine when the printers available at the host computer are available or unavailable; and (3) to determine when a newly added printer is added or connected to the network, so that the network, clients or the users, will be aware of the newly added or connected printer, and to inquire as to what kind of printer language is supported by the newly added printer, therefore, the users or clients will be able to use or employ the newly added or connected printer.

As to claim 46, Sasaki as modified discloses wherein the determiner determines a presence or an absence of a new printer connected to the network by inquiring about management information base information to the network (see Gase et al, see column 1, lines 43-48).

As to claims 48-49, Sasaki discloses an information processing method. The steps of method claims 48-49 claim subject matter corresponding to and similar to the claimed limitations that are found in the information processing apparatus claims of

claims 45-46. Therefore, claims 48-49 are similarly rejected.

As to claims 51-53, Sasaki discloses a computer-readable storage medium for storing a program for implementing an information processing method. The program codes of the computer-readable storage medium of claims 51-53 claim subject matter corresponding to and similar to the claimed limitations that are found in the information processing apparatus claims of claims 45-47. Therefore, claims 51-53 are similarly rejected.

As to claims 54-55, Gase et al teaches a determiner adapted for determining a presence or an absence of a printer connected to a network periodically or to a user's instruction (see column 1, lines 43-64, the user has to send the inquiry by running the NetWare software, which can be run periodically). Therefore, It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Sasaki by the teaching of Gase et al because of the following reason(s): (1) for the reasons taught by Gase et al (see column 1, lines 43-48); and (2) to determine when a newly added printer is added or connected to the network, so that the network or the clients or the users, will be aware of the newly added or connected printer, and to inquire as to what kind of printer languages are supported by the newly added printer, therefore, the users or clients will be able to use or employ the newly added or connected printer.

As to claims 56-57, <u>Sasaki</u> discloses wherein the printer language is used to represent a print job, and the print data is converted according to the printer language supported by the printer, so that the printer can interpret the print data (i.e. col. 6, lines 46-65).

As to claims 58-61, <u>Sasaki</u> discloses an information processing method. The steps of method claims 58-61 claim subject matter corresponding to and similar to the claimed limitations that are found in the information processing apparatus claims of claims 54-57. Therefore, claims 58-61 are similarly rejected.

As to claims 62-65, <u>Sasaki</u> discloses a computer-readable storage medium for storing a program for implementing an information processing method. The program codes of the computer-readable storage medium of claims 62-65 claim subject matter corresponding to and similar to the claimed limitations that are found in the information processing apparatus claims of claims 54-57. Therefore, claims 62-65 are similarly rejected.

Conclusion

5.   Applicant's arguments filed 9/26/03 have been fully considered but they are not persuasive.

In response to applicant's argument against Sasaki, not teaching or suggest a determiner that determines the presence or absence of a printer selected by a user, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). (see details above).

In response to Applicant's argument that Gase et al. Fails to teach or suggest a determiner that sends an inquiry to a network in order to determine a presence or an absence of a printer selected by a user connected to the network. Examiner disagrees with Applicant's conclusion, Examiner asserts that Gase et al. teaches the printer availability is periodically advertised so that a client computer may be informed of the availability, but also teaches actively sending an inquiry about information to a network to determine a presence or an absence of a printer connected to the network (see col. 4, lines 35-37 and col. 5, which describe how an inquiry is send to the printer(s) to determine the presence or absence of the printer by being disconnected, or finding the state of the printer (active or inactive), and Gase et al. clearly teaches that the printer is selected by the user (e.g. col. 6, lines 45-52).

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751.

Any inquiry of a general nature or relating to the status of

this application should be directed to the Group receptionist

whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

        Commissioner of Patents and Trademarks
        Washington, DC 20231

or faxed to:

        (703) 872-9306 (official or unofficial)

Gabriel I. Garcia
Primary Examiner
January 24, 2004   GABRIEL GARCIA
                                        PRIMARY EXAMINER